REMARKS

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the amendments to the Claims, the amendments to the Specification, the Declaration of Mr. Ken Ohmura, which is attached hereto, a Certified English Translation of the Japanese Priority Document and the following Remarks.

One of the novel aspects of the present Invention is the discovery that, by controlling the redispersion electro-conductivity of the toner, a good balance between the static charge property of the black toner and chromatic toners can be obtained. This leads to high reproducibility of fine dots and good color images.

To bring out this aspect of the present Invention, Claims 1 and 7, the independent claims, both recite that the difference of redispersion of electro-conductivity of each of the chromatic toners and the black toners is within a set range of 0.8 to 12 μS/cm. Claims 1 and 7 have been amended to emphasize that this difference is between the chromatic toners and the black toner.

This aspect of the present Invention is brought out in the Specification, for example, at page 10, lines 5-9 wherein it teaches that the difference of the redispersion electro-conductivity is between the chromatic toner and the black toner.

Turning now to the Office Action, Claims 1-8 had been rejected as being anticipated by U.S. Patent Publication No. 2002/0039699. As noted by the Examiner, this is a 102(e) reference which has a filing date of July 24, 2001. The instant Application has a Japanese Priority date of December 15, 2000. Thus, the instant Application has a priority date earlier than the U.S. filing date of the cited reference. In order to remove this cited reference, enclosed herewith is a Certified English Translation of Applicants' Japanese Priority Document. It can be seen in the English Translation of the Japanese Priority Document that the Priority Document supports the claims, as presented herein, in that Claims 1-8 are virtually verbatim on pages 1-3 of the Japanese Priority Document. Respectfully, Applicants have removed the published U.S. Application as prior art.

The second art rejection made by the Examiner was Claims 1-8 as being anticipated by U.S. Patent 6,346,358 to Cheng. It was the Examiner's position that Cheng inherently has the redispersion electro-conductivity as recited in the Claims. In order to prove that Cheng does not have the difference of the redispersion

electro-conductivity recited in the claims, Cheng's material has been prepared and tested. These tests are presented by way of Declaration of Mr. Ken Ohmura as attached hereto. As the Examiner will note, the enclosed Declaration is presently unexecuted. However, the data contained therein originated with Declarant and is, therefore, entirely reliable. The document has been forwarded to the Declarant for signature and, as soon as the completed Declaration is received by us, it will be filed in this case. In the meantime, it is respectfully requested that the Examiner consider the unexecuted Declaration in order to expedite the prosecution of this Application. It will be seen by viewing Tables 3a and 4a that the difference in the redispersion electro-conductivity between the chromatic toners and the black toners falls outside the range of the present Invention. Specifically, it will be seen that the difference in the redispersion electro-conductivity is in the range of 0.4 to -0.4. This is clearly outside the claimed range of 0.8 to 12. Thus, it is respectfully submitted that Cheng does not have the claimed difference of redispersion electro-conductivity of the present Invention.

Applicants also performed a number of tests on the material according to Cheng and compared them to the present Invention. Those tests are presented in Table 5a. Probably the biggest difference between the toners prepared by Cheng to the toners of the present Invention can be seen in the fine dot scattering wherein the present Invention had results A or B and Cheng had a

result of C. The same is also true for the color difference of low temperature and low humidity and fogging at high temperature, high humidity. Thus, it is respectfully submitted that the Declaration of Mr. Ken Ohmura clearly demonstrates that Cheng does not possess the claimed difference of redispersion electro-conductivity of the present Invention and does not have the same characteristics of the toners of the present Invention. These tests clearly show that the material of the Cheng and the material of the present Invention is different and that Cheng does not inherently meet the claimed limitations herein.

The fact that Cheng's material does not meet the difference of redispersion electro-conductivity, as recited in the instant claims, can also be seen by reviewing Cheng itself. The method in which Cheng prepares his toners, namely, the yellow, magenta, cyan, and black toners, follow the same conditions, i.e. polymerization surfactant, washing, drying and so on in the Examples of Cheng. Thus, the black toner is not prepared in any different manner than the chromatic toners. Because he prepares his toners in the same manner, it would be expected that there would not be the difference in the redispersion electro-conductivity as recited in the claims herein.

Respectfully, Applicants have shown that Cheng does not inherently meet the claim limitations of the present Invention and that the present Invention is patentable over the teachings of Cheng.

Now, turning to the other points raised by the Examiner in the outstanding Office Action, each will be addressed in turn. The phraseology of the last sentence in the Specification on page 3 is deemed to be awkward and correction had been requested. This last sentence, which makes up the last paragraph on page 3, has been amended herein. Such amendments are deemed to put the sentence in conventional U.S. phraseology.

Claims 1 and 7 had been objected to because of the misspelling of "not". Claims 1 and 7 have been amended herein to correct this misspelling.

Claims 1-8 had been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, it was unclear what the difference is in the redispersion electro-conductivity of toners relative to each other. As previously brought out, page 10, lines 5-9, make it clear that the difference is between the chromatic toners and the black toner. Claims 1 and 7 have been amended herein to bring out this fact. In order to further illustrate this difference, it can also been seen from Tables 3a and 4a the difference in the redispersion electro-conductivity.

For instance, in Example 1 of the present Invention, the redispersion electro-conductivities are as follows:

Toner	Redispersion Electro-conductivity
Black	2.6
Yellow	12.4
Magenta	12.3
Cyan	11.1

As can be seen, the yellow magenta and cyan toners are relatively close in their redispersion electro-conductivity while the black toner is substantially different. As can be seen, the difference between the chromatic toners and the black toner clearly falls within the claimed range of 0.8 to 12. Specifically, the difference between the black toner and each of the chromatic toners is in the neighborhood of about 10.

Additionally, to emphasize that the present Invention is directed to the differences of the chromatic toners versus the black toner, Claims 1-4 and 6 have been amended to recite that the Invention is to a set of toners and not just a toner. It is submitted that this amendment is simply one of formalistic purposes since the Invention, covered by the Claims, specifically calls for a difference between toners and not just an individual toner.

Claim 3 had been rejected as being indefinite for using the phrase "salting/coagulating". Claim 3 has been amended herein to recite that the process for making the toners calls for a simultaneous salting out, aggregating and fusing. These three steps, which are performed simultaneously to make the toner, are recited on page 22, lines 1-3. It is deemed that such simply clarifies what is meant by the phrase "salting/coagulating".

Claim 5 had been rejected as being indefinite. Claim 5 has been cancelled herein.

Claim 6 had been rejected as being indefinite and, specifically, what was meant by the phrase "the next frequency class". A description of this is provided in the paragraph bridging pages 50-51. The next frequency means next to the highest frequency. That is, the second frequency. In order to demonstrate the histogram with respect to particle size, attached hereto is an example. In the histogram, the third column from the left is the largest. The next frequency class would be that of the second column from the left because the second column from the left is the next highest or tallest in the histogram. It is submitted that one of skill in the art would understand this and that Claim 6, as presented herein, is definite.

Claims 7 and 8 had been rejected as being indefinite since these claims are method claims but did not recite any steps. Claim 7 has been amended herein to specifically recite steps of the method recited in Claim 7. Support for these amendments can be found in the Specification starting at page 55. Claim 8 is dependent upon Claim 7 and, thus, Claim 8 has all of the limitations of Claim 7.

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. A two month extension of time is hereby requested, and PTO Form 2038 is enclosed herewith authorizing payment of the appropriate government extension fee. Should any further fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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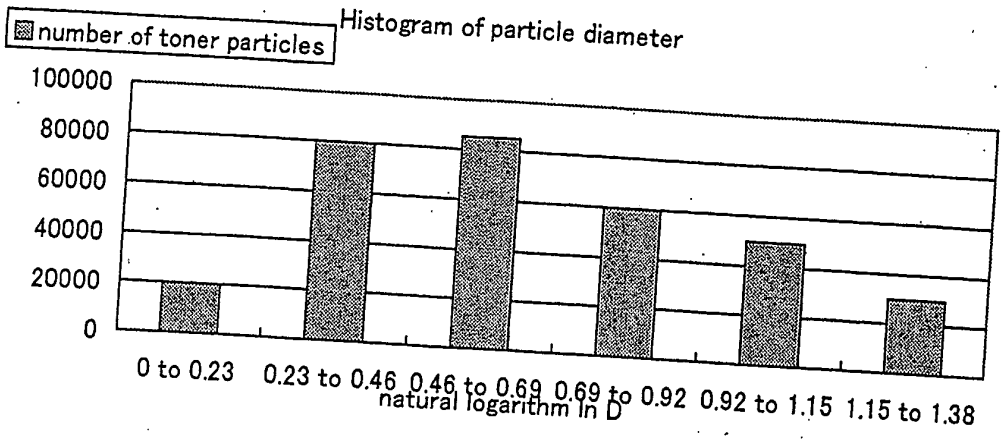
DCL/mr
Encl: Example of histogram
Unexecuted Declaration of Mr. Ken Ohmura
English Translation by Mr. Tsutomu Yoshii of Japanese Priority Document
Executed PTO Form 2038 for $410.00
Return receipt post-card


number of toner particles
Histogram of particle diameter
100000
80000
60000
40000
20000
0
0 to 0.23
0.23 to 0.46
0.46 to 0.69
0.69 to 0.92
0.92 to 1.15
1.15 to 1.38
natural logarithm ln D